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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,226	08/30/2000	Arun K. Gupta	102157-100	2299
26541	7590	02/20/2004	EXAMINER	
RITTER, LANG & KAPLAN 12930 SARATOGA AE. SUITE D1 SARATOGA, CA 95070			MIZRAHI, DIANE D	
			ART UNIT	PAPER NUMBER
			2175	13
DATE MAILED: 02/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/651,226

Applicant(s)

GUPTA, ARUN K.

Examiner

DIANE D. MIZRAHI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 8-16 need to be canceled because they are subject to restriction and/or election requirement.

DIANE D. MIZRAHI
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

III. DETAILED ACTION

Claims 1-16 are presented for examination.

In response to communications filed on December 16, 2003, the Claims 1-16 are pending in the application. Although Claims 8-16 have been withdrawn, Claims 8-16 have not been canceled and are still pending in Applicant's application.

Applicant's arguments regarding Amendment C, paper no. 11C, have been reconsidered but are not deemed persuasive for the reasons set forth below.

Response to Applicant's Remarks

Examiner has completed a through study of Applicant's amendment of December 16, 2003.

Especially, Applicant's Claims 1-7 have been carefully studied and reviewed.

Applicant's amendments to claims 1-7 further direct the claimed invention to a method for extracting desired data for metric analysis.

Examiner asserts that Sheffield (US Patent No. 5,832,431 and Sheffield hereinafter) and Goldberg (US Patent No. 5,907,847 and Goldberg hereinafter) in combination with Medl (US Patent No. 6,108,004 and Medl hereinafter) teaches Applicant's claimed invention of extracting desired data for metric analysis. In

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addition, the specially discussed feature of the claimed invention ("automatically generating executable code from said specified data elements") is very clearly discussed in Goldberg (i.e. An update transaction can include one or more update SQL statements to store modifications to an object (e.g., modifications to the class definition, state, and/or behavior) in the relations. An object can be inserted and deleted using insert and delete (respectively) statements) (col 10, lines 15-21); see also (i.e. An implementation having the characteristics of security, portability and interoperability can be achieved using a programming language such as Java. Java provides the ability to translate a source definition into a series of bytes referred to as byte codes that can run in any standard computing environment without any translation. In addition, Java provides a source checking mechanism that disables execution if the source of the code is not known) (col 7, lines 48-56) see also (Figures 5A, step 504, and col 8, lines 36-39).

In response to the Applicant's arguments for claim 1 that "the cited reference does not support a prima facie case of obviousness" Examiner has "established a *prima facie* case of obviousness", because "obviousness determination requires an evaluation of whether prior art taken as a whole would suggest

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the claimed invention taken as a whole to one of ordinary skill in the art" and that "recited subject matter would not have been obvious to one of ordinary skill in the art based upon the applied patents", the arguments has been fully considered but are not found to be persuasive, because it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But, so long as it takes into account only knowledge which was within the level or ordinary skill at the time of the invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such as reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding the term "automatic" and that the "user does not need to generate source code", "automatic" is clearly taught by Goldberg (i.e. An update transaction can include one or more update SQL statements to store modifications to an object (e.g., modifications to the class definition, state, and/or behavior) in the relations. An object can be inserted and deleted using insert and delete (respectively) statements) (col 10, lines 15-21); see also (i.e. An implementation having the characteristics of security, portability and interoperability can be achieved using a programming language such as Java. Java

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provides the ability to translate a source definition into a series of bytes referred to as byte codes that can run in any standard computing environment without any translation. In addition, Java provides a source checking mechanism that disables execution if the source of the code is not known) (col 7, lines 48-56) see also (Figures 5A, step 504, and col 8, lines 36-39).

Examiner asserts that while the lines in question do state that the source code is generated by a user, the executable code (Java byte code) is generated automatically by the Java VM or compiler.

Examiner asserts that "every limitation positively recited in a claims was given effect in order to determine what the subject matter that the claim defines" *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970) and that Examiner believes that claims 1-7 are not allowable over the prior art of record cited above for reasons provided above.

Examiner asserts that Sheffield (US Patent No. 5,832,431 and Sheffield hereinafter) and Goldberg (US Patent No. 5,907,847 and Goldberg hereinafter) in combination with Medl (US Patent No. 6,108,004 and Medl hereinafter) teaches Applicant's invention.

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Applicant is inaccurate for the reasons explicitly stated in the first Office Action.

These reasons have been explicitly stated in the first Office Action dated August 12, 2003, paper no. 9.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D.

Mizrahi whose telephone number is (703) 305-3806. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (703) 305-3806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-9000 for regular communications and (703) 305-9000 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9001.



Diane Mizrahi
Primary Patent Examiner
Technology Center 2100

February 19, 2004